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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,200	12/19/2000	Heung-For Cheng	42390P10465	7689

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EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/741,200	Applicant(s) CHENG, HEUNG-FOR	
	Examiner Cindy Nguyen	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to request for reconsideration filed 03/19/03.

1. Specification

There is no header "Brief Summary of the Invention". Correction is required.

The specification retains objected to because no header, "Brief summary of the invention" has been provided. Even though a heading is not required, it nonetheless helps structure the disclosure so as to become easier to read. As such header is necessary to make the disclosure easier to read.

2. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6427164) in view of Goodhand et al. (U.S. 5923848) (Goodhand).

Regarding claims 1 and 11, Reilly disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list, comprising:

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a machine accessible medium having instructions encoded thereon, which when executed by the machine (col. 3, lines 61 to col. 4, lines 9, Reilly), are capable of directing the machine to perform receiving a document by a document distribution server (col. 6, lines 66 to col. 7, lines 26, Reilly);

recording in a database an identifier for the document and the distribution list (col. 7, lines 28-62, Reilly);

distributing the document to said members of the distribution list (col. 7, lines 28-62, Reilly);

receiving, in response to distributing to a first member of the distribution list, an error message comprising the identifier (col. 8, lines 8-14, Reilly);

looking up the identifier in the database so as to identify the distribution list (col. 8, lines 15-30, Reilly).

However, Reilly didn't disclose: deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. On the other hand, Goodhand disclose deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (col. 13, lines 40-54, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for the step for deleting member from the distribution list in the system of Reilly as taught by Goodhand. The motivation being to enable the user to automatic deleted unknown user name in the distribution list to avoids receiving error messages during the transmission.

The Examiner directs applicant's attention to column 3, lines 3-10 of Reilly. At the noted excerpt, Reilly specifies that if a forwarding address does not exist, the reference will not attempt to resolve the discrepancy. Instead, Reilly allows the user to correct or update the

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address. Because Reilly desires an updated distribution list, it itself would suggest auto deletion step.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Goodhand disclose: wherein said wastage comprises bandwidth required for: said distributing the document to the nonexistent member (col. 7, lines 28-62, Reilly);

said error message received in response to said distributing (col. 7, lines 28-62, Reilly);
a reply by a second member of the distribution list, in response to said distributing, which is distributed to the nonexistent member; and an error message responsive to said reply (col. 8, lines 50 to col. 9, lines 10, Reilly).

Regarding claims 3 and 12, all the limitations of these claims have been noted in the rejection of claims 1 and 11, respectively. In addition, Reilly/Goodhand disclose: wherein members of the distribution list receive distributions addressed such that replies to said distributions are directed to said members of the distribution list (col. 8, lines 31-49, Reilly).

Regarding claims 4 and 13, all the limitations of these claims have been noted in the rejection of claims 3 and 12, respectively. In addition, Reilly/Goodhand: disposing a Messaging Application Programming Interface (MAPI) application program within a first computing device (col. 13, lines 52-67, Goodhand); composing by the user of the document with said application program (col. 15, lines 64 to 16, col. 6, Goodhand); and disposing the document distribution

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server in a second computing device (col. 15, lines 50-57, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI application program use for composing and disposing in the system of Reilly as taught by Goodhand. The motivation being to make it easy for users to write message application that are independent of the underlying message system and implement messaging features with a small amount of code.

Regarding claims 5 and 14, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Reilly/Goodhand disclose: wherein said application program includes an object-oriented programming language (col. 15, lines 35-49, Goodhand).

Regarding claims 6 and 15, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Reilly/Goodhand disclose: wherein said application program comprises a Microsoft outlook e-mail functionality (col. 8, lines 37-49, Goodhand).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Goodhand disclose: providing a Microsoft windows operating system environment having a messaging application programming interface (MAPI) (col. 15, lines 27-34, Goodhand); disposing a Messaging Application Programming Interface (MAPI) application program within a first computing device (col. 13, lines 52-67, Goodhand); composing by the user

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of the document with said application program (col. 15, lines 64 to col. 16, lines 6, Goodhand); and disposing the document distribution server in a second computing device (col. 15, lines 15-67, Goodhand).

Regarding claims 8 and 17, most of the limitations of these claims have been noted in the rejection of claim 1 above. It is therefore rejected as set forth above. In addition, Reilly/Goodhand disclose: sending the electronic document with said MAPI application program (col. 14, lines 9-25, Goodhand); executing an e-mail application program utilizing a selected one of: Microsoft Messaging Application Programming Interface (MAPI)-based, and Microsoft Active Messaging (col. 13, lines 1-10, Goodhand); addressing the electronic document to the distribution list (col. 13, lines 29-39, Goodhand).

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/Goodhand disclose: further comprising: receiving the error message (col. 7, lines 28-62, Reilly); receiving the electronic document by a distribution server which performs said distributing the electronic document (col. 6, lines 66 to col. 7, lines 26), and looking up the identifier (col. 8, lines 15-30, Reilly).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/Goodhand disclose: further comprising: determining the identifier based on attributes of the electronic document, said

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attributes comprising a subject identifier, a sending time, and a distribution list identifier (col. 15, lines 50-57, Goodhand).

Regarding claim 16, all the limitations of this claim have been noted in the rejection of claim 11. In addition, Reilly/Goodhand disclose: further comprising: a second computing device, communicatively coupled to the system, in which the document distribution server is disposed (col. 15, lines 15-25, Goodhand); and wherein said instructions include further instructions capable of directing the machine to perform: executing a Microsoft Windows operating system environment providing a Messaging Application Programming Interface (col. 15, lines 27-34, Goodhand).

Response to Arguments

Applicant's arguments have been considered, but are moot in view of the new ground(s) of rejection.

4. Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Christie et al. (U.S 5757669), Method and apparatus for workgroup information replication.

Gilchrist et al. (U.S 6205471), Object oriented mail server framework mechanism.

Lee et al. (U.S 6212553). Method for sending and receiving flags and associated data in email transmissions.

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Ouchi (U.S 6442594). Workflow systems and methods.

Coumo et al. (U.S 6012092). Method and system for managing multi user data flows in environment having minimal bandwidth and computational resources.

5. Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN

Cindy Nguyen
April 23, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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